

Remarks

In this Response "A", claims 1 and 3 have been amended, and claims 2, 6, 9, 13 and 14 have been cancelled.

Claim Rejections Under 35 U.S.C. §102

The Examiner has rejected claims 1,2,10-12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,388,427 to Nishikawa. Applicants traverse this rejection for the following reasons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In light of the amendments that have been made to independent claims 1 and 3, and the cancellation of claim 2, the Nishikawa patent does not describe each and every element in claims 1 and 10-12. Amended claim 1 recites, in part, that the alkyd dispersion has a z-average molecular weight greater than 20,000 and an oil length in the range of about 40% to about 70% and an acid value less than 10. The Nishikawa patent does not teach these required elements for its alkyd-stabilized acrylic dispersion. Therefore, claim 1 is not anticipated by the Nishikawa patent. Accordingly, because claims 10 and 12 are dependent from claim 1, these claims are also not anticipated by the Nishikawa patent.

Claims 1, 3 and 8-12 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,734,872 to Wakimoto taken in view of the evidence given in *Printing Paper & Inks*. Applicants traverse this rejection for the following reasons. Amended claims 1 and 3 claim "an alkyd-stabilized acrylic dispersion having a non-volatile materials content of greater than 85%, and wherein the alkyd-stabilized acrylic dispersion comprises:

- (1) an alkyd resin having a non-volatile materials content greater than 70%;
- (2) at least one acrylic monomer suitable for free radical addition polymerization, wherein at least one of the monomers is hydroxy-functional; and a chain transfer agent; wherein the alkyd-stabilized acrylic dispersion has a z-average molecular weight greater than 20,000 and an oil length in the range of about 40% to about 70% and an acid value less than 10; and an ink solvent;

wherein the weight ratio of the alkyd-stabilized acrylic dispersion to the pigment dispersion is from about 45:55 to about 55:45.” The Wakimoto patent does not disclose an alkyd stabilized acrylic dispersion having a NVM greater than 85%, nor an ink composition where the weight ratio of the alkyd-stabilized acrylic dispersion to the pigment dispersion is from about 45:55 to about 55:45. Therefore, independent claims 1 and 3 are not anticipated by the Wakimoto patent, and accordingly, dependent claims 8-12 are not anticipated by the Wakimoto patent.

The Examiner has rejected claims 1-2,4-8 and 10-13 under 35 U.S.C. §102(b) as being anticipated by EP 555503. Applicants traverse this rejection for the following reasons.

In light of the amendments that have been made to independent claims 1 and 3, and the cancellation of claims 2 and 13, the EP 555503 reference does not describe each and every element in claims 1-2, 4-8 and 10-13. Amended claim 1 recites, in part, that the ink composition comprises an ink solvent and that the weight ratio of the alkyd-stabilized acrylic dispersion to the pigment dispersion is from about 45:55 to about 55:45. The EP 555503 reference does not teach these required elements. Therefore, claim 1 is not anticipated by the EP 555503 reference.

Accordingly, because claims 4-8 and 10-12 are dependent from claim 1, these claims are also not anticipated by the EP 555503 reference.

The Examiner has rejected claims 1, 3, 9 and 14 under 35 U.S.C. §102(b) as being anticipated by Amon et al. Applicants traverse this rejection for the following reasons.

In light of the amendments that have been made to independent claims 1 and 3, and the cancellation of claims 9 and 14, the Amon reference does not describe each and every element in claims 1 and 3. Amended claims 1 and 3 recite, in part, that the ink composition comprises an alkyd-stabilized acrylic dispersion having a non-volatile materials content of greater than 85%. The Amon reference does not teach these required elements. Therefore, claims 1 and 3 are not anticipated by the Amon reference.

Claim Rejections Under 35 U.S.C. 103

The Examiner has rejected claims 6-7 under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. or Wakimoto et al, either of which in view of EP 555503. In light of the cancellation of claim 6, Applicants traverse the rejection of claim 7 for the following reasons.

The Examiner asserts that the EP 555503 patent discloses broadly the alkyd stabilized acrylic dispersions as coating compositions, that that it would be obvious to one of ordinary skill in the art to use this alkyd in either Nishikawa et al or Wakimoto et al and thereby arrive at the claimed invention.

The EP 555503 patent does not disclose Applicants' basic inventive concept except for the alkyd-stabilized acrylic dispersion component. Applicants submit that the EP 555503 reference, and not the Applicants' application, must suggest the desirability and thus the obviousness of making the combination that the Examiner has set forth (MPEP Section 2141.) The EP 555503 reference, however, only suggests utilizing the alkyd stabilized acrylic dispersion for coating compositions. Ink compositions have very different desired characteristics than coating compositions, such as suitable consistency and tack for sharp, clean images, suitable drying characteristics, durability and gloss, to name a few, that are critical to the ink formulation. Applicant's invention of utilizing an alkyd-stabilized acrylic dispersion having certain characteristics, in combination with a pigment dispersion, provide for inks having excellent print quality. The alkyd-stabilized acrylic dispersions of Applicant's invention is not a typical "alkyd" as used in most ink compositions, but instead utilizes an acrylic core that is alkyd modified. There is no motivation in any of the cited references to utilize the alkyd modified acrylic dispersion of Applicants' invention.

Moreover, in order to establish *prima facie* obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). It is respectfully submitted that the cited references do not teach or suggest all of the limitations disclosed in claim 7, and the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 7. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, claim 7 is nonobvious and patentable over Nishikawa et al. or Wakimoto et al, either of which in view of EP 555503.

The Examiner has rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over Amon in view of EP 555503 and Wakimoto et. al. The Examiner states that it would have been obvious to one of ordinary skill in the art to use a dispersion of viscosity as described in EP 555503 in Amon to produce ink with excellent dry time and thereby arrive at the claimed invention. Applicants traverse this rejection for the following reasons.

The Amon patent does not disclose Applicants' basic inventive concept of utilizing an alkyd stabilized acrylic dispersion having a non-volatile materials content of greater than 85%. In fact, Amon in view of EP 555503 does not disclose an ink composition that includes the elements of Applicants' claimed invention. Neither Amon nor EP 555503 disclose an ink composition utilizing an alkyd stabilized acrylic dispersion. Thus, Amon in view of EP 555503 does not suggest or grant motivation to utilize Applicants' invention as an ink composition. Accordingly, claim 7 is nonobvious and patentable over Amon in view of EP 555503.

The particular features of the present invention are not taught or in any way suggested by the cited references, taken individually or in combination. The combination of Nishikawa, Wakimoto or EP 555503 neither disclose nor suggest Applicants' invention. Accordingly, there is no motivation to combine these references to provide Applicant's claimed inventions.

Applicant respectfully submits that in rejecting the claims of the present application over Nishikawa, Wakimoto or EP 555503, the Examiner has improperly ignored the key elements of the present invention, and has thus failed to consider the claimed invention as a whole. *Litton Industrial Products, Inc. v. Solid State Systems Corp.*, 755 F.2d 158, 225 USPQ 34 (Fed. Cir. 1985). It is not enough that the Examiner present references that contain assorted features of the invention; rather the Examiner has the burden to show why it would appear that the references would have been combined. Absent some teaching, suggestion, or incentive supporting the combination, obviousness cannot be established by merely combining the teachings of the prior art to produce the claimed invention. Applicant contends there is no teaching, suggestion, nor incentive to combine the teachings of the cited references to show Applicant's claimed invention. It is equally well established that the prior art must provide a motivation or reason for one skilled in the art, without the benefit of Applicant's specification, to make the necessary changes in the reference. Teachings of the references may only be combined if there is some suggestion or incentive to do so. *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). One skilled in the art would not have an incentive to combine the teachings of Nishikawa, Wakimoto or EP 555503 to provide an ink composition having the desired properties of Applicants' invention. This ignorance would, in turn, preclude practice of the Applicants' invention and hence deprive the art of the beneficial and advantageous results that flow therefrom. The Examiner's combination of the cited references cannot, therefore, support a rejection of Applicants' claims based on

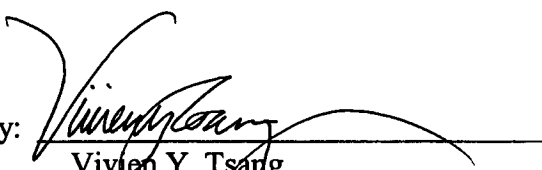
obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 is respectfully requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 19-2025.

Respectfully submitted,

THE SHERWIN-WILLIAMS COMPANY

By: 
Vivien Y. Tsang
Attorney for the Applicants
Reg. No. 40,209

February 24, 2006

The Sherwin-Williams Company
11 Midland Bldg. - Legal Dept.
101 Prospect Avenue, N.W.
Cleveland, Ohio 44115
Phone: (216) 566-2487